

REMARKS

Applicant requests that the above amendments be entered, and that the application be reconsidered in view of these amendments and the following remarks. In the final Office Action, dated December 27, 2004, the Examiner objected to claim 31 as being dependent from a canceled claim. The Examiner further objected to claim 32 as allegedly being in improper dependent form. The Examiner additionally rejected claims 1-4, 7, 11, 12, 23, 24, 29 and 32 under 35 U.S.C. § 102(b) as allegedly being anticipated by U. S. Patent No. 6,371,691 (hereinafter "FINZEL"). The Examiner also rejected claims 6, 13, 28 and 31 under 35 U.S.C. §103(a) as allegedly being unpatentable over FINZEL. Applicant notes with appreciation the Examiner's indication of allowable subject matter in claims 8-10, 25 and 26.

By way of this amendment, Applicant proposes amending claim 1 to incorporate the subject matter of claim 8, which the Examiner has indicated as being allowable. Applicant further proposes amending claims 9 and 31 to depend from claims 1 and 23, respectively. No new matter has been added by way of the present amendment. Reconsideration of the outstanding rejection of claims 1-4, 6, 7, 11-13, 23, 24, 28, 29, 31 and 32 is respectfully requested in view of the amendments above and the following remarks.

In paragraph 3, the final Office Action objects to claim 31 as being dependent upon a canceled claim. Applicant proposes amending claim 31 to depend from claim 30, as suggested by the Examiner. In view of this change in dependency, Applicant respectfully requests withdrawal of the objection to claim 31.

In paragraph 4, the final Office Action objects to claim 32 under 37 C.F.R. § 1.75(c) as allegedly being in improper dependent form for failing to further limit the subject matter of a

previous claim. Claim 32 recites “wherein the first cable is pulled out of, and through, the duct without removing the sealer within the trench.” Independent claim 1 recites “pulling the first cable out of, and through, the duct.” Applicant, therefore, submits that claim 32 further specifies that pulling the cable out of the duct, as recited in claim 1, is performed without removing the sealer within the trench. Claim 32, thus, further defines the subject matter of claim 1, in compliance with 37 C.F.R. § 1.75(c). Withdrawal of this objection is respectfully requested.

In paragraph 7, the final Office Action rejects claims 1-4, 7, 11, 12, 23, 24, 29 and 32 as allegedly being anticipated by FINZEL. Applicant proposes amending claim 1 to incorporate the subject matter of claim 8, which the Examiner has indicated as being allowable. Therefore, claim 1, and dependent claims 2-4, 7, 11, 12 and 32, should be in condition for allowance if this amendment is entered. Applicant traverses with respect to claims 23, 24 and 29.

Independent claim 23 recites a method of placing cable within concrete or asphalt that includes “cutting a trench into the concrete or asphalt to a depth of approximately 3.5 to 4.0 inches from a surface of the concrete or asphalt,” “placing a tubular material having a hollow inner diameter within the trench,” “filling at least a portion of the trench with a sealer,” “placing a first cable within the tubular material,” “removing the first cable from the tubular material without removing the sealer from the trench,” and “placing a second cable within the tubular material without removing the sealer from the trench.”

A proper rejection under 35 U.S.C. § 102 requires that a single reference teach every aspect of the claimed invention. See M.P.E.P. § 2131. FINZEL does not disclose or suggest the combination of features recited in claim 23.

For example, FINZEL does not disclose or suggest “placing a tubular material having a hollow inner diameter within the trench.” The Examiner relied (final Office Action, pg. 3) on the profile body VP, shown in FIGS. 54 and 55 of FINZEL, as allegedly disclosing the placement of a duct in a trench. Applicant submits that the profile body VP of FINZEL does not disclose or suggest “a tubular material having a hollow inner diameter within the trench,” as recited in claim 23. As described in column 26, lines 4-21, and clearly shown in FIG. 54, the material of profile body VP includes an elongate, roughly rectangular shape, with a rounded lower portion, that includes elastic barbs VH protruding out from each side of the rectangular shaped profile body VP. Ducts FK are further disposed within the inner portion of the elongate, rectangular shaped profile body VP. Thus, though profile body VP does have a hollow inner diameter (i.e., duct FK), the elongate, rectangular shape of the material of profile body VP is not a “tubular material” as recited in claim 23. The material of profile body VP does not have the form or shape of a tube and, therefore, is not “tubular” as recited in claim 23.

The final Office Action further cites column 26, lines 4 through 21 as allegedly disclosing “placing a second cable within the tubular material without removing the sealer from the trench.”

At column 26, lines 4 through 21, FINZEL discloses:

FIG. 54 shows the cross-section through an elongate profile body VP comprising a solid profile which has elastic properties, but cannot be deformed plastically. The profile body is fixed in the laying channel by elastic barbs WH. Arranged within the profile body VP are longitudinally running free ducts FK into which fibres can be drawn or blown at a later point in time. Provided in the upper region of the profile body VP is a duct for a microcable MK which is introduced into the profile body VP in the direction GR, through a longitudinally running slit VPS, before the laying operation.

FIG. 55 shows the profile body VP of FIG. 54 within the laying channel VN, the elastic barbs WH having been wedged along the channel wall. Additional optical waveguides may possibly be drawn or blown into the free ducts FK of the profile body VP at a subsequent point in time. The upper part of the laying channel VN is, once again, filled with a sealant B.

This section of FINZEL, thus, merely discloses that optical waveguides may be drawn or blown into the ducts FK of profile body VP. Nowhere in this section, or in any other section, does FINZEL disclose, or even suggest, “placing a first cable within the tubular material,” “removing the first cable from the tubular material without removing the sealer from the trench,” and “placing a second cable within the tubular material without removing the sealer from the trench,” as recited in claim 23. FINZEL, thus, does not disclose, either in the section cited by the Office Action, or anywhere else in the entirety of its disclosure, a cable repair process that includes placement of a first cable within a tubular material, removal of the first cable without removing sealer from the trench in which the tubular material is placed, and placement of another cable within the tubular material without removing the sealer from the trench. FINZEL, therefore, does not suggest or disclose the combination of features of claim 23 noted above.

For at least the above reasons, Applicant submits that FINZEL does not anticipate claim 23. Withdrawal of the rejection of claim 23 is, therefore, respectfully requested.

Claims 24 and 29 depend from claim 23 and, therefore, patentably distinguish over FINZEL for at least the reasons set forth above with respect to claim 23.

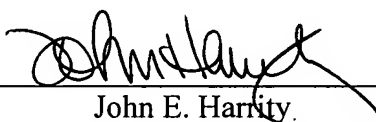
In paragraph 9, the final Office Action rejects claims 6, 13, 28 and 31 under 35 U.S.C. §103(a) as allegedly being unpatentable over FINZEL. Claims 6 and 13 depend from claim 1 and, for the same reasons applicable to claim 1 noted above, should also be in condition for

allowance. With respect to claims 28 and 31, the final Office Action alleges that various features recited in these claims are either inherent, or well-known in the art. Applicant notes, however, that these allegations of the final Office Action do not remedy the deficiencies in the disclosure of FINZEL noted above with respect to claim 23. Applicant, thus, requests withdrawal of the rejection of claims 28 and 31 for at least the reasons set forth with respect to claim 23 above.

In view of the foregoing remarks, Applicant respectfully requests that this amendment be entered. Applicant further requests the Examiner's reconsideration and withdrawal of the outstanding rejections, and the timely allowance of this application. Applicant submits that the proposed amendments do not raise new issues or necessitate the undertaking of any additionally search of the art by the Examiner. Furthermore, Applicant submits that the entry of this amendment would place the application in better form for appeal in the event that the application is not allowed.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 13-2491 and please credit any excess fees to such deposit account.

Respectfully submitted,

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